

Appl. No. 10/025,668  
Amdt. dated March 14, 2006  
Reply to Office Action of December 14, 2005

### REMARKS

Applicants have carefully reviewed the Office Action mailed December 14, 2005, prior to preparing this response. Currently, claims 1-16 and 20-38 are pending in the application, wherein claims 1-16 and 20-38 have been rejected. Claims 1 and 37 have been amended, and claims 39-44 have been added. No new matter has been added with these amendments. Favorable consideration of the following remarks is respectfully requested.

Claims 1, 5, 6, 20, 24 and 25 stand rejected under 35 U.S.C. §102(b) as being anticipated by Schroepfel et al., U.S. Patent No. 5,957,966. Applicants respectfully traverse this rejection.

Independent claims 1 and 20 each recite a polymer jacket comprising a shape memory polymer "attached to" a portion of the core wire (emphasis added). Applicants assert Schroepfel at least fails to teach this limitation as claimed in claims 1 and 20. In the Office Action, the Examiner equates the conductor wire (42) taught in Schroepfel with the core wire as currently claimed, and the Examiner equates the segments (28) (30) of the sleeve (12) with the polymer jacket comprising a shape memory polymer as currently claimed, as the segments (28) (30) are disclosed as being composed of a shape memory polymer. See Schroepfel, column 5, lines 50-52.

Contrary to the Examiner's suggestion in the rejection, Schroepfel fails to teach what is claimed in either of claim 1 or claim 20. Namely, in the Figures of Schroepfel, the conductor wire (42) is loosely coiled within the confines of the sleeve (12) and not attached to either segment (28) or segment (30) of the sleeve (12). See Figs. 2, 5, 6, 7 and 8, for example. As shown in the Figures, the conductor wire (42) is spaced away from the sleeve (12) such that the conductor wire (42) is not attached to or otherwise in contact with the sleeve (12).

As Schroepfel at least fails to teach this limitation of claims 1 and 20, Schroepfel fails to anticipate these claims. Claims 5 and 6, which depend from claim 1 and add additional limitations, and claims 24 and 25, which depend from claim 20 and add additional limitations, are also believed patentable for at least the reasons stated above.

Claims 1, 36 and 37 stand rejected under 35 U.S.C. §102(e) as being anticipated by Zhou, U.S. Patent Application Publication No. 2002/0183654. Applicants respectfully traverse this rejection.

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Claim 1 recites that the polymer jacket encases a portion of the core wire. Zhou at least fails to teach this limitation of claim 1. As shown in Figure 2, for example, the second tip member (128) (which the Examiner equates to a polymer jacket) is not encasing a portion of the elongate member (106) (which the Examiner equates with a core wire). In view of what is taught in Zhou, in order for the guidewire tip portion disclosed in Zhou to function properly, the second tip member (128) should not encase the elongate member (106). Functionality of the guidewire tip portion disclosed in Zhou is dependent on the ability of the first tip member (126) of the elongate member (106) to deflect a distance prior to engaging the second tip member (128). See, for example, Zhou, paragraph 20. Thus, the first tip member (126) must be spaced away from the second tip member (128) in order to allow deflection of the first tip member (126) prior to engaging the second tip member (128). If the second tip member (128) was encasing the elongate member (106), then deflection of the first tip member (126) of the elongate member (106) would be thwarted since the first tip member (126) of the elongate member (106) would be unable to deflect before engaging the second tip member (128). For at least this reason Applicants assert claim 1 is patentable over Zhou, as Zhou fails to anticipate claim 1. Likewise, claim 37, which depends from claim 1 and includes additional limitations, is also believed patentable over Zhou. Withdrawal of the rejection is respectfully requested.

Claim 36 recites "a polymer jacket attached to and surrounding a portion of the core wire including the tapered portion and the distal end of the core wire." Applicants assert Zhou at least fails to teach this limitation of claim 36. As shown in Figure 2, for example, the distal end (134) of the elongate member (106) (which the Examiner equates to a core wire) extends distal of the second tip member (128) (which the Examiner equates to a polymer jacket). Thus, Zhou at least fails to teach the distal end of the core wire is surrounded by and attached to a polymer jacket as currently claimed. For at least this reason Applicants assert claim 36 is patentable over Zhou, as Zhou fails to anticipate claim 36. Withdrawal of the rejection is respectfully requested.

Claims 7-16 and 26-35 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Schroepfel et al., U.S. Patent No. 5,957,966, in view of Takahashi, U.S. Patent No. 6,485,458. Applicants respectfully traverse this rejection. Claims 7-16 depend from claim 1, and claims 26-35 depend from claim 20. Claims 1 and 20 are believed patentable over the teachings of Schroepfel for at least the reasons stated above. Takahashi fails to remedy the shortcomings of

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Schroeppel in order to establish a *prima facie* case of obviousness. Therefore, these claims are additionally believed allowable.

Claims 1-5, 20-24 and 36-38 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Burmeister et al., U.S. Patent No. 5,452,726, in view of Schroepel et al., U.S. Patent No. 6,024,764. Applicants respectfully traverse this rejection, asserting a *prima facie* case of obviousness has not been established with the cited combination.

In formulating the rejection, the Examiner states, and the Applicants agree, "Burmeister et al. fails to disclose the polymer jacket being a shape memory polymer more stiff than the portion of the core wire which it surrounds." The Examiner goes on to state that Schroepel teaches a "polymer jacket being a shape memory polymer more stiff than the portion of the core wire which it surrounds." Applicants respectfully disagree with this assessment of Schroepel. At no point does Schroepel teach a polymer jacket being more stiff than the portion of the core wire which it surrounds. Thus, at least this limitation as currently claimed is not taught by the cited combination.

As shown in Figure 2 of Schroepel, the tubular sleeve (14) surrounds a portion of the tubular member (10). However, there is no mention throughout Schroepel of the material composition of the tubular member (10), especially no mention that the tubular member (10) is metallic. Furthermore, referring to Figure 2, Schroepel teaches a plurality of barbs (24) on the tubular sleeve (14) "penetrate slightly into the exterior surface of the implantable tubular device (10)," thus seemingly negating a suggestion that the tubular member (10) may be metallic. Schroepel, column 4, lines 27-31.

Furthermore, Schroepel suggests "In addition to relying on the deformation properties of the material used to fabricate the sleeve (12), structure may be incorporated into the sleeve (12) to enable the implanting surgeon to plastically deform the sleeve (12) into the desired shape" Schroepel, column 6, lines 36-40. Schroepel then describes several embodiments of a rib (28) that can be plastically deformed by hand or with the aid of hand tools. See Schroepel, column 6, line 36 through column 7, line 5. It is noted that in these embodiments, it is the stiffness of the rib (28), not the polymeric sleeve (12), that retains the deformed shape. Thus, contrary to the Examiner's assertion, Schroepel does not provide the suggestion of a polymer jacket being more stiff than the portion of the core wire which it surrounds.

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As neither Schroepfel nor Burmeister teach the limitation of the polymer jacket being more stiff than the portion of the core wire which it surrounds, a *prima facie* case of obviousness has not been established regarding claims 1, 20 and 36. For at least this reason, these claims are believed patentable over the cited references. Claims 2-5, 21-24 and 37-38, which depend from one of claims 1, 20 or 36 and include additional limitations, are also believed patentable over the cited references. Withdrawal of the rejection is respectfully requested.

Claims 39-44 have been added with this amendment. In view of the remarks provided above regarding the patentability of claims 1-16 and 20-38, Applicants assert the prior art of record additionally fails to teach that claimed in claims 39-44.

Reexamination and reconsideration are respectfully requested. It is respectfully submitted that all pending claims are now in condition for allowance. Issuance of a Notice of Allowance in due course is requested. If a telephone conference might be of assistance, please contact the undersigned attorney at (612) 677-9050.

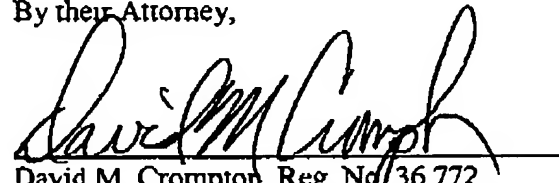
Respectfully submitted,

Stephen Griffin et al.

By their Attorney,

Date: \_\_\_\_\_

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David M. Crompton, Reg. No. 36,772  
CROMPTON, SEAGER & TUFTE, LLC  
1221 Nicollet Avenue, Suite 800  
Minneapolis, MN 55403-2420  
Telephone: (612) 677-9050  
Facsimile: (612) 359-9349